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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/588,610

04/27/2007

Eduardo Aldecoa Anitua

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8345

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EXAMINER

LAWSON, MATTHEW JAMES

ART UNIT

PAPER NUMBER

3775

MAIL DATE

DELIVERY MODE

12/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/588,610	Applicant(s) ANITUA, EDUARDO ALDECOA	
	Examiner MATTHEW LAWSON	Art Unit 3775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/24/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 9-12 in the reply filed on October 1st, 2009 is acknowledged. The traversal is on the ground(s) that the common technical feature of claims 9 and 13 of the retention zones does define a contribution over the prior art. This is not found persuasive because as claimed the first invention never positively recites "tissue retention zones." Further the applicants arguments are directed towards claims 6 and 12, claim 6 being a canceled claimed and are therefore moot. Lastly, the special technical feature the applicant is contending as claimed is functional and the device of Peltier is only required to be capable of performing this function which it is; any tool bit will accumulate some amount of residual material within the trough of the blade(s) and therefore would be a retention zone. The requirement is still deemed proper and is therefore made FINAL.

2. Claims 13-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Group II, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 1st, 2009.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The applicant currently uses legal phraseology as emphasized above within the body of the abstract along with the use of parenthesis which are to be avoided both within the abstract and the body of claims.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It appears the applicant is attempting to incorporate by reference a previous application of theirs in the specification along with positively reciting this application

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within the body of the claim. The applicant has failed to properly incorporate the reference within the body of the specification and further does not explicitly state what they are claiming or what is meant to be cited from the prior application within the claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jorneus et al. (US 5,741,267) in view of Yeung Wai Ping (US 2006/0111724) in view of Meller (US 2004/0210229).

Jorneus et al. disclose a milling procedure to be carried out on the bone, cartilage or other patient tissue in order to form a cavity (figures 2-5) of a shape and size that allows it to house an implant or prosthesis (figures 1 and 6) or for other purposes in which a cavity needs to be formed, with the procedure being based on the repeated application of various rotating milling tools (figures 2-6) on the tissue until the required cavity is formed, with the procedure comprising an intermediate phase in which the depth, width and other main features of the cavity are defined (figures 3-4) and an optional countersinking phase (figure 5) in which the mouth of the cavity is widened

Jorneus et al. do not disclose the intermediate, countersinking, or initial phase of tool use being operated at low speeds ranging from between 20 and 80 rpm, nor does

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Jorrneus et al. discloses no use of irrigation solution being applied on the tools, loose tissue particles, or the tissue surrounding the mill hole or cavity during the low speed milling process.

Yeung Wai Pin discloses the low speed milling of target tissue (¶52) between about 20 and 80 rpm without the application of irrigation solution to the tools, loose tissue particles or the tissue surrounding the mill hole or cavity during the act of low speed milling. It is commonly known in the art the use of low speed milling is advantageous because it creates less heat on the target tissue which results in less opportunity for heat damage to the target tissue and possibly avascular necrosis of the target tissue.

Further, Jorneus et al. in view of Yeung Wai Ping fail to disclose alone or in combination the tissue particles displaced or extracted as a result of the milling process are collected for subsequent use in other surgical processes, the recovery of the tissue is not being dependent on the use of suction machines and being based on that the tissue displaced or extracted during the milling process is housed in the milling tool as a result of the retentive design of the tool, so that when the tool is taken out these particles are extracted from it and can be used or stored as appropriate for other surgical uses, and the tissue particles collected during the milling process are mixed with Plasma Rich in Growth Factors or with other biological materials for desirable medical purposes.

Meller discloses the collection of displaced or extracted tissue particles as a result of the milling process and are collected for subsequent use in other surgical

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processes (figures 1-6, ¶3-6, and 72) and being housed in the milling tool as a result of the retentive design of the tool (figures 1-6), so that when the tool is taken out these particles are extracted from it and can be used or stored as appropriate for other surgical uses, and the tissue particles collected during the milling process are mixed with Plasma Rich in Growth Factors or with other biological materials for desirable medical purposes (figures 1-6, ¶3-6, and 72).

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to have constructed the method of Jorneus et al. to be performed at a low speeds without irrigation of the he tools, loose tissue particles or the tissue surrounding the mill hole or cavity as taught by Yueng Wai Ping because it creates less heat on the target tissue which results in less opportunity for heat damage to the target tissue and possibly avascular necrosis of the target tissue. Further, it would have been obvious to one or ordinary skill in the art at the time the invention was made to have the method of Jorneus et al. to including collection of collecting the tissue particles displaced or extracted as a result of the milling process for subsequent use in other surgical processes, the recovery not being dependent on the use of suction machines and so that when the tool is taken out these particles are extracted from it and can be used or stored as appropriate for other surgical uses as taught by Meller to better fixate the implant within the milled out surgical site.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. **See attached PTO-892.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW LAWSON whose telephone number is (571)270-7375. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Barrett can be reached on 571-272-4746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. L./
Examiner, Art Unit 3775

/Thomas C. Barrett/
Supervisory Patent Examiner, Art
Unit 3775